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PATENT
Docket No.: 019009-000420US

TOWNSEND and TOWNSEND and CREW LLP

By: Peggy Nichols
Peggy Nichols

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Stephen Y.F. Pang

Application No.: 09/353,537

Filed: July 14, 1999

For: SYSTEM FOR POLICING JUNK
E-MAIL MESSAGES

Confirmation No.: 3726

Examiner: Chuong T. Ho

Art Unit: 2664

REQUEST FOR REHEARING UNDER
37 C.F.R. §41.52.

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant requests for a rehearing under 37 CFR §41.52 from the Decision on Appeal from the Board of Patent Appeals and Interferences. Appellant believes that there are points misapprehended or overlooked by the Board. The points to be reconsidered are provided below under the bolded headings.

McCormick- "Policing Server" (All Claims)

Appellant asserts that the Board overlooked the true interpretation of the claimed policing server. See, page 8 of the Decision on Appeal. Although the Board specifically referred to Appellant's definition of "policing server" on page 7 of the brief, the Board's interpretation of the policing server appears incorrect. That is, the Board indicated that: "filtering unwanted email via a server is an action that would, at least at the user's inbox, reduce the incidence of further identical SPAM email messages sent from the same

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spammer." The Board also stated that the "examiner's construction of 'policing server' to include the system of McCormick is therefore reasonable." Bottom of Page 8 and top of page 9 of the DECISION OF APPEAL.

As explained by the Appellant, the term "policing server" was explained as "a server that performs actions to reduce the incidence of further SPAM e-mail messages sent *from one or more spammers.*" [Emphasis Added.] In contrast, McCormick merely suggests a filtering system that receives the unwanted SPAM from the one or more spammers and filters them out. A clear point of difference, which Appellant has emphasized, is that the present policing server performs actions to reduce the incidence of further SPAM e-mail messages sent from one or more spammers. To make it clear in an example, the policing server stops the SPAM at the source, which can be another server or node on the network. The SPAM, which is stopped, never enters the system taught by McCormick. (Using a real property example in drug enforcement, the present policing server would stop drug production (or SPAM production) at the source while the McCormick server would stop drug traffic (or SPAM messages) at the border. As can be seen, the concept of the claimed policing server is substantially different from the conventional filter system taught by McCormick.)

As noted before and further emphasized, Appellant's definition is fully supported by the specification. As discussed above, both the provisional application and the present patent application disclose that "policing servers" perform "pro-active" actions in response to an unwanted e-mail, actions that are more than merely updating an e-mail filter. Examples of "pro-active" actions disclosed include, contacting the spammer's ISP, contacting governmental authorities to impose fines and levy penalties on the spammer, initiating private legal action against the spammer, submitting the spammer's ISP to a black list, and the like.

The Board overlooked Appellant's definition of the policing server. The claimed policing server performs actions to reduce the incidence of further SPAM e-mail

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messages sent from one or more spammers. McCormick, however, taught a filtering system that does not reduce the incidence of further SPAM e-mail messages sent from one or more spammers but teaches blocking messages at a filter. As an example, the present policing server prevents the SPAM from ever reaching the filter and blocks the SPAM at its source, which is the clear difference between McCormick and the claimed policing server. Accordingly, Appellant believes that all claims are patentable.

McCormick and Gianni (1-10 and 13-19)

Appellant also disagrees that there is a prima facie case of obviousness in combining McCormick and Gianni. As previously noted, Gianni is also a passive system for personal e-mail messages, which has nothing to do with the claimed policing server. Accordingly, even if McCormick and Gianni are combined, they still fail to teach the claimed policing sever. The policing server performs actions to reduce the incidence of further SPAM e-mail messages sent from one or more spammers. As noted above, the policing server stops the SPAM at the source, which can be another server or the like. The SPAM, which is stopped, never enters the system taught by McCormick. Accordingly, claims 3, 4, 6-10, 15, 16, 18, and 19 are patentable.

McCormick, Gianni, and Macavinta (claims 11, 12, and 20)

Again, the Board relied upon McCormick teaching the claimed policing sever. Appellants disagree with the Board's interpretation of the claimed policing server and characterization of Macavinta. The combination of McCormick, Gianni, and Macavinta fail to show or suggest the claimed policing sever in the manner recited by claims 11, 12, and 20. As previously noted, the policing server performs actions to reduce the incidence of further SPAM e-mail messages sent from one or more spammers. As noted again emphasized herein, the policing server stops the SPAM at the source, which can be

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another server or the like. The SPAM, which is stopped, never enters the system taught by McCormick.

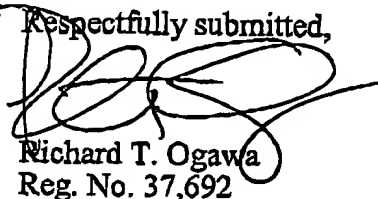
Importantly, Macavinta fails to show or suggest the claimed policing server. Macavinta merely recites certain proposed powers of the FTC in a general sense and fails to show or suggest the claimed invention. Nowhere in Macavinta is any teaching of the FTC stopping SPAM at the source, which is provided with the claimed policing server. Nowhere in Macavinta is the claimed policing server that provides a practical way of stopping SPAM at the source. Most importantly, Macavinta does not state that the FTC has been mandated to stop SPAM. Accordingly, claims 11, 12, and 20 are patentable.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. This Appeal Brief is filed in triplicate.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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Atty Docket No. 019009-000420US

PTO FAX NO.: 1-571-273-0042

ATTENTION: Board of Appeals

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FOR THE PERSONAL ATTENTION OF
The Board of Appeals

CERTIFICATION OF FACSIMILE TRANSMISSION

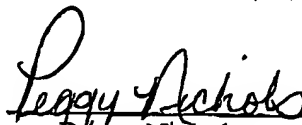
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Documents Attached

1. Transmittal and Request for Rehearing Under 37 CFR §41.52

Number of pages being transmitted, including this page: 6

Dated: August 30, 2006


Peggy Nichols

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PTO/SB/21 (09-04)

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

5

Application Number

09/353,537

Filing Date

July 14, 1999

First Named Inventor

Pang, Stephen Y.F.

Art Unit

2664

Examiner Name

Chuong T. Ho

Attorney Docket Number

019009-000420US

ENCLOSURES (Check all that apply)

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)



Reply to Missing Parts/ Incomplete Application



Reply to Missing Parts under 37 CFR 1.52 or 1.53



Drawing(s)



Licensing-related Papers



Petition



Petition to Convert to a Provisional Application



Power of Attorney, Revocation Change of Correspondence Address.



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) _____



Landscape Table on CD



After Allowance Communication to TC



Appeal Communication to Board of Appeals and Interferences



Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)



Proprietary Information



Status Letter



Other Enclosure(s) (please identify below):

Request for Rehearing Under 37 CFR 41.52

Remarks

The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

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Firm Name

Townsend and Townsend and Crew LLP

Signature



Printed name

Richard T. Ogawa

Date

August 30, 2006

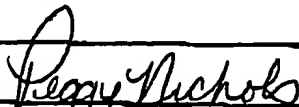
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